

REMARKS

Concurrently herewith a petition under 37 CFR 1.181 to withdraw finality of an office action is being filed.

In the Office Action of July 3, 2006, the Office stated the present application contained subject matter that was allowable except as to form, pointed out such subject matter, and suggested how it may be amended, as required by MPEP 707.07(j)(II) (Action of July 3, 2006, paragraphs 32, 33, and 34). The MPEP states that such a statement is to be made "If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form" (MPEP 707.07(j)(II)). Applicant complied with the instructions contained within the Action of July 3, 2006 for amending the claims containing the allowable subject matter in Applicant's response, filed January 3, 2007. Each of the dependent claims that were deemed allowable if rewritten in independent form by the Action of July 3, 2006, was amended to be written in independent form or combined with the rejected independent claim on which it was dependent. Applicant believed the claims were in proper form for allowance.

A Final Office Action was issued on March 29, 2007. The Final Action contains final rejection of each independent and dependent claim pending in the application, and cites a new reference U.S. Pat. No. 6,467,027 B1 (Kyker) not cited in any previous Action nor provided on any IDS submitted by the Applicant, stating that Applicant's amendments necessitated the new grounds of rejection. As of the Action of March 29, 2007, Applicants are effectively cut off from responding to the new grounds of rejection. Applicant respectfully requests that the finality of the present Action and the newly cited reference Kyker be rescinded. Applicant further requests that the claims be allowed, or that prosecution continue on the merits.

MPEP 706.04 states that "a claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action. Great care should be exercised in authorizing such a rejection." When the Action of July 3, 2006 stated that claims 6-9, 11, 15, 21 and 29 were allowable except for form, they were noted as allowable claims under MPEP 706.04. Therefore, rejection of these claims may only be made under MPEP 706.04. Although a supervisory patent

examiner has signed the present Action, there is no evidence in the present Action that would demonstrate that the primary examiner has considered all of the facts in granting approval to the rejection. The rejections contained within the Action are primarily the same as those contained in the July 3, 2006 Action, with the exception of the newly cited reference Kyker in the rejection of claim 11. No reasoning is provided as to why claims containing the subject matter which was noted as allowable in the Action of July 3, 2006, are now rejected in light of the same references over which the subject matter was previously deemed allowable, or why a new reference is now cited to reject claim 11, also previously deemed allowable.

For example, Applicant's response of January 3, 2007 amended independent claim 1 to include the allowable subject matter of claim 6 as well as rejected claim 5. The present action rejects claim 1 under 35 U.S.C. 112 for being indefinite, and for being obvious under 35 U.S.C. 103(a) in light of U.S. Patent No. 6,257,774 B1 (Stack) in view of U.S. Patent No. 5,301,287 (Herrel). The obviousness rejection is a combination of the rejection of claims 1 and 5 from the Action of July 3, 2006. The indefiniteness rejection is based on the inclusion of the phrase "certain point" in the claim. Claim 6 was not rejected in the Action of July 3, 2006 for either indefiniteness, despite containing the "certain point" phrase, or obviousness. No argument is made as to the obviousness of the allowable subject matter from claim 6 that is now in independent claim 1. If claim 6 was obvious in light of Stack in view of Herrel, the claim would have been rejected in the Action of July 3, 2006 along with claim 5, and not included in the Allowable Subject Matter section of that Action. Claim 6 was not rejected for obviousness in light of Stack in view of Herrel in the Action of July 3, 2006, and therefore a claim incorporating the allowable subject matter of claim 6 cannot be rejected in light of Stack in view of Herrel in the present Action without citation of further references. Claim 1 is therefore allowable over Stack in view of Herrel. Claim 1 is not indefinite, as claim 6 was pointed out as being allowable by the Office despite containing the same phrase that is now cited as grounds for an indefiniteness rejection. Further, the reuse of arguments from the July 3, 2006 Action to reject claims containing subject matter previously deemed allowable indicates that the rejections in the present Action do not comply with MPEP 706.04, as all the facts have not been considered by the primary examiner, and therefore the finality of the present Action should be rescinded.

The above argument applies to claim 12, 18, and 26 as well, as each now contains allowable subject matter as pointed out in the Action of July 3, 2006, but was rejected on the same grounds and in view of the same references over which the allowable subject matter was previously deemed allowable.

The finality of the present Action, with regards to all claims, and especially claim 11, should also be rescinded under MPEP 706.07. MPEP 706.07 states that "While the rules no longer give to an applicant the right to 'amend as often as the examiner presents new references or reasons for rejection,' present practice does not sanction hasty and ill-considered final rejections," and further "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." Final rejection on second action, when accompanied by a new grounds of rejection, is only allowable under MPEP 706.07(a) when the new grounds are "necessitated by applicant's amendment of the claims" or "based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

The present Action relies on new grounds of rejection, such as the new reference Kyker used in the rejection of claim 11, and states that they were necessitated by the amendments to the claims by Applicant to justify the finality of the rejection under 706.07(a). The amendments to the claims made by Applicant in Applicant's response of January 3, 2007 were made at the suggestion of the Office, found in the Action of July 3, 2006, that the amendments would result in the allowance of the application. Having induced the Applicant to make these amendments by stating that the subject matter would be allowable if such amendments were made, it is improper now for the Office to rely on the amendments to justify the new grounds of rejection and the finality of the rejections in the Final Action. Had the Office not stated that subject matter would be allowable if amended, Applicant may have chosen to not amend at all, or to not amend in a manner that would have necessitated the new grounds of rejection.

Applicant amended the claims based on the Office's suggestions, as MPEP 706.07 also states that "it is in the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits." Applicant was led to believe that the amendments would result in the allowance of the amended claims, resulting in a quick and efficient close of prosecution with issuance. The finality of the Final Action is in contravention to the previously stated guidelines for prosecution, that final rejections should not be hasty and prosecution should not be prematurely cut off, as the finality of the Action is based on amendments made because the Office suggested such amendments would result in the allowance of claims in the Allowable Subject Matter section of the action of July 3, 2006. The citing of new art and making the Office Action final based on claims amendments suggested by the Office unfairly prevent applicant from responding to the new rejections. Applicant was prevented from prosecuting the application. The finality of the present action should be rescinded.

Moreover, the claim amendments merely combined claims with the independent claims from which they depend. As all claims should have been considered in issuing the initial Office Action, it is unclear how combining dependent and independent claims could necessitate further consideration and additional grounds of rejection.

Based on the above, the Applicant respectfully requests that the finality of the present Action be rescinded, and that the new reference Kyker introduced in the Action be likewise rescinded. Applicant further requests that the present claims, containing allowable subject matter as pointed out in the Action of July 3, 2006, be allowed.

Application No. 10/035,604

Docket No.: 35997-215548

Reply dated June 22, 2007

Reply to Office Action of ~~July 3, 2006~~ March 29, 2007

If the Examiner is of the opinion that the prosecution of this application would be advanced by a personal interview, the Examiner is invited to telephone undersigned counsel to arrange for such an interview.

The Commissioner is authorized to charge any fee necessitated by this Amendment to our Deposit Account No. 22-0261.

Dated: June 22, 2007

Respectfully submitted,

By 

Jeffri A. Kaminski

Registration No.: 42,709

James R. Burdett

Registration No.: 31,594

VENABLE LLP

P.O. Box 34385

Washington, DC 20043-9998

(202) 344-4000

(202) 344-8300 (Fax)

Attorney/Agent For Applicant